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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,410	11/27/2001	Carolynn Rae Johnson	PU010272	7497

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JOSEPH S. TRIPOLI
THOMSON MULTIMEDIA LICENSING INC.
2 INDEPENDENCE WAY
P.O. BOX 5312
PRINCETON, NJ 08543-5312

EXAMINER

FLETCHER, JAMES A

ART UNIT	PAPER NUMBER
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2615

DATE MAILED: 08/14/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/994,410

Applicant(s)

JOHNSON, CAROLYNN RAE

Examiner

James A. Fletcher

Art Unit

2615

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 November 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-4, 6-8, 10-15, 17-19, 21 and 22 are rejected under 35 U.S.C. 102(b) as being anticipated by Okada et al (6,181,870).

Regarding claims 1 and 12, Okada et al disclose a method and system of generating a customized video recording compilation, comprising the steps of:

- presenting a menu which lists at least a portion of video segments recorded on a first storage medium (Fig 77A shows a menu that includes a directory with a plurality of files named "MovieX.VOB");
- prompting a user to select at least one video segment from the menu (Fig. 77A, "Press one Key");
- compiling each video segment selected by the user to create at least one compilation (Fig. 77B "Specify desired cell section to be partially reproduced between first original PGC and third original PGC"); and
- inserting the compilation as a new item in the menu (Fig.85 shows "User_DefinedPGC#1" as being ready to be added to the menu once it has been defined in the compilation step above).

Regarding claims 2 and 13, Okada et al disclose a method and system of generating a customized video recording compilation comprising transferring at least one video segment in the compilation from the first storage medium to a second storage medium (Fig 41, item 100 "Disc Recording unit" and item 101 "Disc Reading Unit" and Fig 1B, illustrating "Source Materials" and "Editing Result").

Regarding claims 3 and 14, Okada et al disclose a method and system of generating a customized video recording compilation comprising the steps of:

- prompting the user to place each selected video segment in an order (Fig 42 "Desired Reproduction Order Set In File"); and
- placing the selected video segments in the order to reflect a customized viewing sequence (Fig 42 "File Linked In Desired Reproduction Order").

Regarding claims 4, 6, 15, and 17, Okada et al disclose a method and system of generating a customized video recording compilation comprising automatically transferring all video segments in the compilation from the first storage medium to a second storage medium with a single intervention from the user (Col 93, line 62- Col 94, line 2 "the editing multi-stage control unit instructs the title reproduction control unit to reproduce the VOBs in accordance with the PGC, out of the user-defined PGCs, that has been indicated by the user").

Regarding claims 7 and 18, Okada et al disclose a method and system of generating a customized video recording compilation wherein the first storage medium can be selected from the group comprising an optical disc medium or a magneto disc medium (Fig 2A "DVD RAM" and Fig 69C, "Writing from HD to DVD-RAM").

Regarding claims 8 and 19, Okada et al disclose a method and system of generating a customized video recording compilation wherein the second storage medium can be selected from the group comprising an optical disc medium, a magneto disc medium, a digital tape medium or an analog tape medium (Fig 2A "DVD RAM" and Fig 1, indicating tape media for both recording and reproducing).

3. Claims 1, 3, 12, and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Kazami et al (6,035,093).

Regarding claims 1 and 12, Kazami et al disclose a method and system of generating a customized video recording compilation, comprising the steps of:

- presenting a menu which lists at least a portion of video segments recorded on a first storage medium (Col 2, lines 62-64 "list display means for causing the media drive means to acquire and produce identifying information about image files on the recording medium");
- prompting a user to select at least one video segment from the menu (Col 2, line 66-Col 3, line 1 "file selecting means for selecting, in accordance with an external selecting operation, among the listed image files displayed by the list display means");
- compiling each video segment selected by the user to create at least one compilation (Col 2, lines 8-12 "when "compile movie" on file menu or the like is selected, the computer creates a single image file by sequentially linking the corresponding image files in the order of the thumbnail images arranged in editing region"); and

- inserting the compilation as a new item in the menu (Col 3, lines 19-21 “the list display means continues display of the list of image files on a recording medium after ejecting of that recording medium” and Fig 6, item 53, and Col 1, lines 42-44 “an editing region is displayed for appropriately placing thumbnail images” and Col 6, lines 45-48 “a playback button for initiating a playback operation is displayed”).

Regarding claims 3 and 14, Kazami et al disclose a method and system of generating a customized video recording compilation comprising the steps of:

- prompting the user to place each selected video segment in an order (Col 6, lines 64-67 “the microprocessor reads the file name of the selected image file and records it in the memory along with the selection order data numerically indicating the position [first, second, etc.] of that image file in the order of selected image files”); and
- placing the selected video segments in the order to reflect a customized viewing sequence (Col 2, lines 9-11, “the computer creates a single image file by sequentially linking the corresponding image files in the order of the thumbnail images arranged in editing region”).

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 5, 9, 16, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Okada et al as applied to claims 1, 2, 6, 7, 12, 13, 17, and 18 above, and further in view of Saito et al (6,085,020).

Regarding claims 5 and 16, Okada et al suggest a method and system of generating a customized video recording compilation comprising:

- prompting the user to create an identifier for the compilation (Col 80, lines 24-31 "The differences between original PGCs and user-defined PGCs are as described above, but, from the viewpoint of the user, there is no need to be aware of such differences... As a result, both kinds of PGCs are managed in the same way using a unit called a 'video title'") but does not specifically disclose prompting the user for an identifier for the compilation.

Saito teaches the naming of a compilation of video segments (Col 8, line 27 "The keyboard is used to enter the EDL name"); and

- designating the compilation with the identifier (Col 8, line 27 "The keyboard is used to enter the EDL name").

As suggested by Okada and taught by Saito, naming of files is a well-known and accepted method of identifying files so they can be selected from a group of similar files. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide a prompt for the naming of the video segment and to use that name as the identification of the compilation file.

Regarding claims 9 and 20, Okada et al suggests a method and system of generating a customized video recording compilation wherein the first storage medium is a hard disc drive (HDD) (Col 2, lines 42-44 "improvements could be made by using a video editing setup that utilizes a recording medium which allows random access, such as a hard disc"), but does not specifically disclose the use of a hard disc as the first storage medium.

Saito teaches the use of a hard disc drive as the source of programs to be selected for compilation (Col 3, lines 62-65 "By using a hard disk drive... quick access can be made to any material recorded on the hard disk." The access of material recorded on the disk indicates that the disk is being used as a source of data.).

As suggested by Okada and taught by Saito, hard disk drives are well known and commercially available means of storing and retrieving data at a high speed and with little effort on the part of the user. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to use a hard disk or disc as the source of the data for the compilation.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James A. Fletcher whose telephone number is (703) 305-3464. The examiner can normally be reached on 7:45AM - 5:45PM M-Th, first Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Christensen can be reached at (703) 308-9644.

Any response to this action should be mailed to:

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Commissioner of Patents and Trademarks

Washington, DC 20231


or faxed to:

(703) 872-9314 (for Technology Center 2600 only).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

JAF
July 26, 2003


VINCENT BOCCIO
PRIMARY EXAMINER